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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/605,056	06/28/00	KOYAMA	K P107344-0000

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ARENT FOX KINTNER PLOTKIN & KAHN PLLC
1050 CONNECTICUT AVENUE N W
SUITE 600
WASHINGTON DC 20036-5339

EXAMINER	
COLAIANNI, M	
ART UNIT	PAPER NUMBER
1731	
DATE MAILED: 12/54/00	

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/605,056

Applicant(s)

Koyama et al.

Examiner

Michael Colaianni

Group Art Unit

1731



☒ Responsive to communication(s) filed on Jun 28, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-14 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Jun 28, 2000 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Drawings

1. Figures 21 and 22 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Japan on October 6, 1995. It is noted, however, that applicant has not filed a certified copy of the Japanese applications as required by 35 U.S.C. 119(b).

It is noted that this is a continuation of 08/726175, however, this application is lost in the Office and unable for review at the time of issuing this action. Thus, it was impossible for the Examiner to verify if the requirements of §119 have been satisfied at this time.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 1, 9 and 12 all contain the language "a tape winding portion." It is not clear how the "tape winding portion" and the reels are inter-related. From Figure 8, reference number 12 represents the tape winding portion. It is noted that tape winding portion 12 also contains the feed reel 21. So it is not clear if the "tape winding portion" is merely another way of say the feed reel or is completely separate part of the invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Ono et al.

5430904.

Ono et al. teach applicant's claimed invention comprising: a case having shape and dimensions to be held and manipulated by one hand (col. 6, lines 45-55); a feed reel rotatably provided in the case and winding a coat film transfer tape (col. 11, lines 33); a take-up reel rotatably provided in the case and collecting the coat film transfer tape after use (col. 11, line 35); an interlock means for linking said feed and take-up reels so as to cooperate with each other (col. 11, lines 41), and a coat film transfer head protruding at a front end of the case and pressing the coat film transfer tape onto an object of transfer (col. 6, line 49); a clutch means for synchronizing, at least in one of the feed and take-up reels a feed, a feed speed and take-up speed of the coat film transfer tape between the feed and take-up reels; wherein the clutch means

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composes, at least in one of the feed and take-up reels, power transmission means provided between a tape winding portion for winding up the coat film transfer tape and a rotary drive unit for rotating and driving the tape winding portion (col. 11, lines 41-54), and is composed by frictionally engaging with each other engaging portions formed in confronting axial end surfaces of the tape winding portion and the rotary drive unit (Figure 12, ref. nos. 7, 8, 10 and col. 11, lines 45-51); and wherein power transmission means is from a frictional force caused by a thrust load between the tape winding portion and the rotary drive unit, and is connected and disconnected by a difference in torque therebetween, the thrust load, which causes the frictional force, is set by predetermined relational dimensions of the tape winding portion and the rotary drive unit in the axial direction between the tape winding portion and the rotary drive unit (col. 11, lines 41-54, the thrust force between the members 7 and 8 controls the amount of torque supplied to the feed reel).

Ono et al. also teaches claim 12 (col. 11, lines 31-59).

Ono et al. further teach that the tape rewinding means of claim 15 has an axial free end and the rewinding operation unit is integrally formed at the end surface of the free end (Fig. 3, ref. no. 9 and 1c). Also, Ono et al. teach that the clutch mechanism is placed in both the feed reel and take-up reel (Fig. 16, ref. nos. 9, 7 and 10).

7. Claims 1-2 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Tucker 5310445.

Tucker teaches applicant's claimed invention of a clutch mechanism for a film transfer tool

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having a feed reel and a take-up reel rotatably provided in a hand-held case the two reels being synchronized (col. 2, lines 56-57 and 60-66), power transmission means between the tape winding portion for winding-up the coat film and a rotary drive unit for rotating and driving the tape winding portion, the power transmission means being composed by frictionally and directly engaging with each other engaging portions formed in confronting axial end surfaces of the tape winding portion and the rotary drive unit (col. 4, lines 22-29, Figure 9) and wherein the power transmission means is from a frictional force caused by a thrust load between the tape winding portion and the rotary drive unit and is connected and disconnected by a difference in torque therebetween, the thrust load, which causes the frictional force, is set by predetermined relational dimensions of the tape winding portion and the rotary drive unit in the axial direction between the tape winding portion and the rotary drive unit (Fig. 8, ref. nos. 20, 22, 30, 48, the spring 48 produces a thrust force against the clutch plate 20 to provide for an efficient clutch action).

Tucker also teaches that the the first and second engaging surface is in the shape of annular ribs (Fig. 2, ref. no. 20 and Fig. 6, ref. no. 45; here "annular" has been interpreted to mean ribs arranged in the shape of a ring, which is taught by Tucker).

Tucker also teaches using a position defining unit for suppressing distance between axial end surfaces of the tape winding portion and the rotary drive unit (Fig. 8, ref. no. 48, the spring 48 maintains the force between the clutch plate 20 and tape winding portion 22).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

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rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 3-7 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Tucker 5310445 in view of Ono et al. 5430904.

Tucker substantially teaches applicant's claimed invention. See the above 35 U.S.C. §102(b) rejection above for Tucker's teachings. However Tucker does not explicitly teach the various combinations of flat and ribbed frictional surfaces as claimed in claims 3-7.

However, Ono et al. teach that using a flat surface in combination with a ribbed surface is well known in the film transfer tool clutch mechanism art (Fig. 12, ref. nos. 7, 8, 10 and 12). Thus, using the various claimed combinations of a flat surfaces and ribbed surfaces to achieve the clutch action that is desired would have been obvious in view of Ono et al.'s teachings. Moreover, combining the flat surface in combination with a ribbed surface with Tucker's clutch would have been obvious because doing so would have made for a simpler construction and would have achieved the same desired clutch mechanism result.

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Moreover, regarding claim 7 directed to using a flange with elasticity as part of the frictional engagement in the clutch mechanism, Ono et al. does teach a series of raised ridges that form a square pattern surrounds the reel and support the slip ring (Fig. 15, ref. no. 12 and 15). These raised ridges serve the same purpose as the raised flange and changing the shape of the ridges from a square shape to a circular shape is deemed an obvious design choice.

It would have been prima facie obvious at the time the invention as made to combine Ono et al.'s clutch surfaces and an annular elastic flange with Tucker's transfer film clutch mechanism for the reasons given above in the body of this rejection. Also, the choice of shape of the engagement surfaces has no bearing on the strength or other characteristics of the device, so the particular choice is also merely an obvious design choice.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Colaianni whose telephone number is (703) 305-5493. The examiner can normally be reached on Monday to Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on (703) 308-3837. The fax phone number for this Group is (703) 305-7115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0651.

Michael Colaianni
November 30, 2000

